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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,649	06/29/2001	Anthony Ford	97,338-A3	1141
20306	7590	03/25/2004	EXAMINER	
MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606			GAKH, YELENA G	
			ART UNIT	PAPER NUMBER
			1743	

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/896,649	FORD ET AL.
	Examiner	Art Unit
	Yelena G. Gakh, Ph.D.	1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 29 June 2001.  
 2a) This action is **FINAL**.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 81-99 is/are pending in the application.  
 4a) Of the above claim(s) 97-99 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 81-96 is/are rejected.  
 7) Claim(s) 82-91 and 93-96 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 29 June 2001 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 07/23/02.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. Preliminary Amendment filed on 06/29/01 is acknowledged. Claims 1-80 are cancelled without prejudice. Claims 81-99 are pending in the application.

### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 81-96, drawn to a fluid dispenser, classified in class 422, subclass 100.
  - II. Claims 97-99, drawn to a method for dispensing fluid, classified in class 73, subclass 863.32.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the method can be practiced with a dispenser, which does not comprise a coupler.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Blair Hughes on 03/19/04 a provisional election was made with traverse to prosecute the invention of Group I, claims 81-96. Affirmation of this election must be made by applicant in replying to this Office action. Claims 97-99 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Drawings***

4. The drawings are objected to, because Figures 13B and 13C do not show “holes” in the piston the way they are disclosed in the specification (page 47). It is also not clear, what the number 454, which is presumably supposed to refer to the piston, points to. Is this the piston wall? Then does it mean that the extension does not have this wall? Are the holes in the piston wall? The drawings are unclear and confusing.

***Specification***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. The specification is objected to as not being, written in “such full, clear, concise, and exact terms as to enable any person skilled in the art to practice the invention in its best mode”.

Particularly, on page 47, the specification refers to Figures 13B and 13C and discloses “holes 806 where the extension piece is attached to the bottom of the piston 454” (line 13). It is not clear from the specification or from the drawings, what these holes are and where they are located. Their role is also not clear.

***Claim Objections***

7. Claims 86, 87 and 95-96 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claims render to the operation of the dispenser, rather than its configuration, and therefore do not impose any further limitations to the dispenser structure.

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8. Claims 82-91 and 93-96 refer to **the** dispenser recited in claims 80 and 92, respectively, and therefore a definite article “the” should be used for reciting “dispenser” in these claims.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 81-96 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 81 and 92 recite, “the piston having at least one hole on the side portion”. As it was indicated before, the specification did not disclose, what this hole might be, and the drawings did not clearly show such hole(s). Therefore, it is not clear, what this “at least one hole on the side portion” of the piston might be, or where it is located. This limitation renders claims unclear and indefinite.

Claims 83 and 92 are rejected to as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: the relation between the seal and the piston. It is not clear from the claims, where the seal should be located to perform the function recited in the claims.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. **Claims 81-96** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanna et al. (US 4,964,544) in view of Bazilyanskii (SU 777440 B, Abstract).

Hanna discloses "a push up fluid dispenser having a fluid storage container and a vertically oriented plunger [piston] carried in the container, with the plunger being manually pushable upward for dispensing fluid from the container. The container includes a valve cylinder mounted in the container and having an upper opening and an interior passage for slidably receiving the plunger, and the plunger having a fluid flow passage therein providing a flow path from the cylinder interior to the exterior of the dispenser. A first one-way valve is disposed for control of fluid flow into the cylinder interior through an upper opening and a second one-way valve is disposed for control of fluid flow from the cylinder interior into the plunger passage, with a spring between the cylinder and plunger urging the plunger downward" (Abstract).

Hanna does not specifically disclose a side hole in the piston.

Bazilyanskii discloses a "microdispenser, comprises a casing (1) housing a spring-loaded piston (12) with a rod and a contactor (7), and a cap (15). To increase efficiency, the rod carries

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a hollow piston 10 with holes in its side and free to rotate, while parts (1, 15) contain channels linking the cavity under piston (10) to the cavity above the liquid and then to the atmosphere".

It would have been obvious for anyone of ordinary skill in the art to modify Hanna's dispenser with the piston having side holes in it for the reasons indicated by Bazilyanskii, i.e. "to increase efficiency" of dispenser.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yelena G. Gakh, Ph.D. whose telephone number is (571) 272-1257. The examiner can normally be reached on 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Yelena G. Gakh  
3/22/04

